IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	
Thomas M. **DeMARTINI** *et al.*	Group Art Unit: 3621
Serial No. 10/796,067	Examiner: Shahid KAMAL
Filed: March 10, 2004	Confirmation Number: 2653
For: **RIGHTS EXPRESSION PROFILE SYSTEM AND METHOD**	Date: February 9, 2009

APPEAL BRIEF

Mail Stop Appeal Brief–Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 35 U.S.C. § 134 and 37 C.F.R. § 41.37, Appellants submit the following Appeal Brief in support of the appeal proceedings instituted by the Notice of Appeal filed on January 17, 2009, and in response to the Final Office Action mailed October 17, 2008, in connection with the above-captioned patent application.

I. REAL PARTY IN INTEREST

ContentGuard, Inc. is the assignee and real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences known to the Appellants, the Appellants' representative, or the Assignee, which will directly affect or be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

For the purposes of this Appeal, claims 1, 3-11, 13-23, and 25-33 are pending. Claims 2, 12, and 24 were previously canceled. This Appeal is taken from the rejection of claims 1, 3-11, 13-23, and 25-33 in the Final Office Action mailed on October 17, 2008, and as set forth in the Claims Appendix submitted with this Appeal Brief.

IV. STATUS OF AMENDMENTS

No amendments to the claims have been entered subsequent to the Final Office Action mailed October 17, 2008.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This Appeal is taken from the rejection of claims 1, 3-11, 13-23, and 25-33. Claims 1, 5, 11, 15, 23, and 27 are independent claims. The present invention is generally directed to systems, methods, and devices for controlling use of content through rights expressions associated with the content and to a system and method for profiling rights expressions.

Independent claim 1 relates to a method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with

the rights expression. See Figures 1 and at least paragraphs [0003, 0009-0011, 0028, 0031-0034, 0037, 0050, 0098, 0110, 0122, 0139] of the present specification. The method of claim 1 includes specifying rights expression information 142 indicating a manner of use of an item 134. The rights expression information 142 includes at least one element, and the element has a variable and corresponding value for the variable. See Figures 1, 2, 7, 10, Table 5, and at least paragraphs [0010, 0011, 0034, 0041, 0044-0046, 0063, 0077, 0097, 0115, 0137]. The method of claim 1 also recites generating a template T1 of the rights expression information 142, including removing the value for the variable from the element. See Figures 3, 4, 6, 9, 10, 11, and 12, Table 2, and at least paragraphs [0030, 0034, 0040-0047, 0079-0087, 0092-0095, 0101-0112, 0119-0130]. Claim 1 also includes generating an identification for the template T1 and transmitting the identification for the template T1 to a device 301 adapted to situationally determine the variable and enforce the rights expression information based on the variable and the identification for the template T1. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 0144]. Claim 1 further recites that the rights expression information can be enforced on a device 301 based on the variable and the identification for the template T1.

Independent claim 5 recites a method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression. The method of claim 5 includes specifying rights expression information 142 indicating a manner of use of an item 134. See Figures 1 and at least paragraphs [0003, 0009-0011, 0028, 0031-0034, 0037, 0050, 0098, 0110, 0122, 0139] of the present specification. The rights expression information 142 includes at least one element, and the element has a variable and corresponding value for the variable. See Figures 1, 2, 7, 10, Table 5, and at least paragraphs [0010, 0011, 0034, 0041, 0044-0046, 0063, 0077, 0097, 0115, 0137]. Claim 5 also recites generating a template T1 of the rights expression

information 142, including removing the value for the variable from the element and generating an identification for the template. See Figures 3, 4, 6, 9, 10, 11, and 12, Table 2, and at least paragraphs [0030, 0034, 0040-0047, 0079-0087, 0092-0095, 0101-0112, 0119-0130]. Additionally, claim 5 recites transmitting the identification for the template T1 along with machine-interpretable reconstruction instructions to a device 301, where the device 301 is adapted to follow the machine-interpretable reconstruction instructions to determine the variable and enforce the rights expression information based on the variable and the identification for the template. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 144]. Claim 5 further recites that the rights expression information 142 can be enforced on a device 301 based on the variable and the identification for the template. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 144].

Independent claim 11 recites a system for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression. The system 100 of claim 11 includes means for specifying 130 rights expression information 142 indicating a manner of use of an item 134. See Figures 1 and at least paragraphs [0003, 0009-0011, 0028, 0031-0034, 0037, 0050, 0098, 0110, 0122, 0139] of the present specification. The rights expression information 142 includes at least one element, and the element has a variable and corresponding value for the variable. See Figures 1, 2, 7, 10, Table 5, and at least paragraphs [0010, 0011, 0034, 0041, 0044-0046, 0063, 0077, 0097, 0115, 0137]. The system 100 of claim 11 further recites means for generating 300 a template T1 of the rights expression information 142, including removing the value for the variable from the element. See Figures 3, 4, 6, 9, 10, 11, and 12, Table 2, and at least paragraphs [0030, 0034, 0040-0047, 0079-0087, 0092-0095, 0101-0112, 0119-0130]. Likewise, claim 11 recites means for generating an identification 140 for the template and means for

transmitting 140 the identification for the template to a device 301 adapted to situationally determine the variable and enforce the rights expression information based on the variable and the identification for the template T1. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 0144]. The rights expression information can be enforced on a device 301 based on the variable and the identification for the template T1. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 144].

Independent claim 15 recites a system for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression. The system 100 of claim 15 includes means for specifying 130 rights expression information 142 indicating a manner of use of an item 134. See Figures 1 and at least paragraphs [0003, 0009-0011, 0028, 0031-0034, 0037, 0050, 0098, 0110, 0122, 0139] of the present specification. The rights expression information 142 includes at least one element, and the element has a variable and corresponding value for the variable. See Figures 1, 2, 7, 10, Table 5, and at least paragraphs [0010, 0011, 0034, 0041, 0044-0046, 0063, 0077, 0097, 0115, 0137]. Likewise, claim 15 recites means for generating an identification 140 for the template and means for transmitting 140 the identification for the template along with machine-interpretable reconstruction instructions 909 to a device 301 adapted to follow the machine-interpretable reconstruction instructions to determine the variable and enforce the rights expression information based on the variable and the identification for the template T1. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 0144]. The rights expression information can be enforced on a device 301 based on the variable and the identification for the template T1. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 144].

Independent claim 23 recites a device for controlling use of an item in accordance with a rights expression for use in a system for creating the rights expression for association with the item. The device 100 of claim 23 further recites means for receiving an identification 140 for a template T1 of rights expression information 142 and a variable from the rights expression information 142. See Figures 3, 4, 6, 9, 10, 11, and 12, Table 2, and at least paragraphs [0010, 0011, 0030, 0034, 0035, 0040-0047, 0063, 0077-0087, 0092-0097, 0101-0112, 0119-0130, 0137, 0139-0141]. The rights expression information 142 indicates a manner of use of an item and includes at least one element having the variable and a corresponding value for the variable. See Figures 1, 2, 7, 10, Table 5, and at least paragraphs [0010, 0011, 0034, 0041, 0044-0046, 0063, 0077, 0097, 0115, 0137]. The template T1 of the rights expression information 142 includes the value for the variable removed from the element. The device recited in claim 23 also includes means for situationally determining the variable and enforcing the rights expression information 142 based on the variable and the identification for the template T1.

Independent claim 27 recites a device for controlling use of an item in accordance with a rights expression for use in a system for creating the rights expression for association with the item. The device of claim 27 includes means for receiving an identification 140 for a template T1 of rights expression information 142 and a variable from the rights expression information 142. See Figures 3, 4, 6, 9, 10, 11, and 12, Table 2, and at least paragraphs [0010, 0011, 0030, 0034, 0035, 0040-0047, 0063, 0077-0087, 0092-0097, 0101-0112, 0119-0130, 0137, 0139-0141]. The rights expression information 142 indicates a manner of use of an item and includes at least one element having the variable and a corresponding value for the variable. See Figures 1, 2, 7, 10, Table 5, and at least paragraphs [0010, 0011, 0034, 0041, 0044-0046, 0063, 0077, 0097, 0115, 0137]. The template T1 of the rights expression information 142 includes the value for the variable removed from the element. Claim 27

further recites means for situationally determining the variable and enforcing the rights expression information based on the variable and the identification for the template. See Figures 3, 7, 8, 11, and 12 and at least paragraphs [0010, 0011, 0045, 0117, 0138-0141, and 0144]. The device also includes means for receiving the identification for the template along with machine-interpretable reconstruction instructions and means for following the machine-interpretable reconstruction instructions to determine the variable and enforce the rights expression information based on the variable and the identification for the template.

An embodiment of the present invention provides a system and method for expressing and enforcing usage rights and conditions associated with content using a license template. The usage rights expression and enforcement employs a license template and a template identification. A variable from variable fields of the license can be extracted until the employed values are removed from the license to generate a template that corresponds to the license. A template identifier can be assigned, and the template identifier and an extracted value can be transmitted as the encoded license. The license may be decoded and reconstructed at the receiving end using the template identifier and the received and reconstructed values for the license variables. This enables a minimum amount of data to be transmitted and provides an efficient and lossless manner of presenting the license in order for a user to consume the content.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. The ground of rejection to be reviewed on appeal is the rejection of claim 1 and claims 3-11, 13-23, and 25-33 under 35 U.S.C. § 102(e) as anticipated by Gilliam et al. U.S. Patent Number 7,206,765 ("the Gilliam patent").

VII. ARGUMENTS

A. The Rejection of Claim 1 and Claims 3-11, 13-23, and 25-33 under 35 U.S.C. § 102 as Anticipated by Gilliam et al. U.S. Patent Number 7,206,765 should be REVERSED.

Claim 1 and claims 3-11, 13-23, and 25-33 stand rejected under 35 U.S.C. § 102(e) as anticipated by Gilliam et al. U.S. Patent Number 7,206,765 ("the Gilliam patent"). Appellants appeal this rejection and request reversal because the Gilliam patent fails to disclose or suggest each feature recited in claim 1 and claims 3-11, 13-23, and 25-33.

The present invention allows licensors and users to conserve computing and network resources when expressing and enforcing usage rights and conditions associated with digital content. By using a license template and variables and values in the license template, a licensor can transmit, and a user can reconstruct, a license for content without the need for transmitting or receiving the entire license. A license template is generated by extracting variables from the variable fields of the license. The generated template corresponds to the original license. A template identifier is assigned, and the template identifier and an extracted value(s) are transmitted as the encoded license. The template identifier and extracted value(s) may be decoded, and the license may be reconstructed at the receiving end using the template identifier and the received and reconstructed values for the license variables. By transmitting the license template identifier, variables, and values, the entire license does not have to be transmitted in order for a user to present the license to consume the content.

1. Claim 1 Recites Features Not Disclosed or Suggested by the Gilliam Patent

Independent claim 1 recites a method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression. The method of independent claim 1 includes specifying rights expression

information indicating a manner of use of an item where the rights expression information includes at least one element, and the element has a variable and corresponding value for the variable. The method recited in claim 1 also includes generating a template of the rights expression information, including removing the value for the variable from the element, generating an identification for the template, and transmitting the identification for the template to a device adapted to situationally determine the variable and enforce the rights expression information based on the variable and the identification for the template. Claim 1 further recites that the rights expression information can be enforced on a device based on the variable and the identification for the template.

The Gilliam patent, on the other hand, discloses managing usage rights based on rules. The Gilliam patent discloses a potential recipient specifying a first rights expression indicating a first manner of use of an item proposed by the potential recipient and a provider of an item specifying a second manner of use of the item and determining if there is a correspondence between the first rights expression and the second rights expression. See col. 3, of the Gilliam patent, starting on line 6.

2. The Gilliam Patent Does Not Disclose or Suggest Specifying an Element Having a Variable and Corresponding Value for the Variable

The Gilliam patent describes a system to manage usage rights by matching a rights expression of a potential recipient with a rights expression of a provider to specify and enforce property rights for items such as goods and services. See col. 5, lines 53-62 of the Gilliam patent. On page 3 of the Final Office Action, the Examiner asserts that the Gilliam patent discloses "a) specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a

variable and corresponding value for said variable," and cites col. 7, lines 11-23; col. 8, lines 1-9; col. 23, lines 34-47; and col. 26, lines 2-15 of the Gilliam patent to support this assertion.

However, these sections of the Gilliam patent disclose that one or more conditions can be satisfied in order to exercise the manner of use in a specified usage right. See col. 7, starting at line 11. This section mentions a "manner of use" but does not disclose or suggest a method of creating a rights expression for controlling use of an item where the rights expression information includes at least one element, and the element has a variable and corresponding value for the variable as recited in claim 1 of the present application.

Additionally, in column 8, lines 3-4, the Gilliam patent discusses that a rights language can be used to express a rights expression specifying the rights, conditions, state variables, and the like, for the rights label. However, the mention of a "state variable" in the Gilliam patent is different than "an element having a variable" as recited in claim 1 of the present invention. A state variable is a number representing a state of the usage right. For example, the state variable of the Gilliam patent is akin to a counter that represents how many times something has been used. In contrast, an "element having a variable" as recited in independent claim 1, is a profiling technique for omitting a particular piece of information, which can be a right, a resource, a principal, and the like. It is not a counter or number that is updated as actions are performed.

The term "variable" in the present application is used with respect to a "template or profile". In the present application, variables are the "holes" in the template. The present specification discloses, "An exemplary encoding process can include removing one or more values for variable fields from a rights expression to generate a template or profile for the rights expression." Please see paragraph [0044] of the present application. "It is determined whether or not the license is in the profile by comparing the license and the profile to determine if the license and the profile are similar except for having different values for one

or more corresponding variable values." See paragraph [0077] and Figure 2 of the present application. The state variables described in the Gilliam patent represent counters that indicate status of use. Appellants respectfully submit that the Gilliam patent fails to disclose or suggest specifying rights expression information including an element having a variable and corresponding value for the variable as recited in claim 1 of the present application.

3. The Gilliam Patent Does Not Disclose or Suggest Generating a Template of the Rights Expression Information, Including Removing the Value for the Variable from the Element

Independent claim 1 of the present application also recites, "generating a template of said rights expression information, including removing said value for said variable from said element ...." On page 3 of the Final Office Action, the Examiner asserts that the Gilliam patent discloses this limitation and cites col. 9, lines 6-22; col. 11, lines 6-11; and col. 7, lines 39-55 of the Gilliam patent to support this assertion. However, in the cited portions of the Gilliam patent, there is no disclosure or suggestion of removing the value for the variable from the element of the rights expression information as recited in claim 1 of the present application. Instead, col. 9, lines 6-22 discusses conditions and prerequisites that are to be satisfied before a license server in accordance with the Gilliam patent is accessed by a Web server. The license server then generates the license. The Gilliam patent goes on to discuss that the license can include usage rights, but there is no disclosure or suggestion that the value for the variable is removed from the element as required by claim 1 of the present application.

The other portions of the Gilliam patent also fail to disclose or suggest the claimed limitation. For example, in col. 11, lines 6-11, the Gilliam patent discloses that the rights offer may include creating, deriving, or otherwise utilizing information that relates to rights expressions, and that in an exemplary embodiment, the rights offer can be in the form of a

pre-defined specification, profile, template, and the like, that can be associated with the protected content. This portion of the Gilliam patent appears to discuss a rights offer as a completed profile or template, but there is no disclosure or suggestion of removing the value for the variable from the element of the rights expression information as recited in claim 1 of the present application. The license in the Gilliam patent has all the values filled in, while a license in accordance with the present invention has a template generated and is represented by a template identification in conjunction with the values of the variables.

Similarly, in col. 7, lines 39-55 of the Gilliam patent, the discussion relates to state variables and not to variable fields in a license that may be removed to generate a template. In the cited portions of the Gilliam patent, there is no disclosure or suggestion of removing the value for the variable from the element of the rights expression information as recited in claim 1 of the present application. Instead, col. 7, lines 39-55 of the Gilliam patent discusses an exemplary embodiment where:

> [S]tate variables can be used to track dynamic states, conditions, and the like. For example, the state variables can include variables having values that represent the status of an item, the status of usage rights, the status of a license or other dynamic conditions. The state variables can be tracked, for example, by clearinghouse 160 or another device, based on identification mechanisms in the license 142 and the ticket 134.

The Gilliam patent goes on to discuss an exemplary embodiment where the value of the state variables can be used in a condition.

> For example, a usage right can include the right to redeem the item ticket 134 for specified goods and a condition can include that the usage right can be exercised three times. Each time the usage right is exercised, the value of the state variable can be incremented. In an exemplary embodiment, when the value of the state variable reaches three, the condition can no longer be satisfied and the ticket 134 can no longer be redeemed.

See the Gilliam patent, col. 7, lines 39-46.

However, there is no disclosure or suggestion in the Gilliam patent that the value for the variable is removed from the element as required by claim 1 of the present invention. State variables are not in the rights expression recited in claim 1 of the present invention, and as described above, state variables are not the same as the variable fields in the template. The Examiner's interpretation that the Gilliam patent's "each time the usage rights [sic] is exercised, the value of the state variable can be incremented" somehow discloses that the value for the variable is removed from the element is unfounded and is not supported by the Gilliam patent. See page 3 of the Final Office Action mailed October 17, 2008. As such, Appellants respectfully submit that the Gilliam patent fails to disclose or suggest generating a template of said rights expression information, including removing said value for said variable form said element as recited in claim 1 of the present application.

4. The Gilliam Patent Does Not Disclose or Suggest Generating an Identification for the Template

Independent claim 1 of the present application recites, "generating an identification for said template," and the Examiner asserts that the Gilliam patent discloses this limitation and cites Figures 1 and 3 of the Gilliam patent and the associated text. Figure 1 of the Gilliam patent illustrates "an exemplary digital rights management system on which various exemplary embodiments of the present [Gilliam] invention can be implemented" while Figure 3 illustrates an exemplary license that can be employed in the exemplary systems of the Gilliam patent. See the Brief Description of the Drawings in the Gilliam patent. As shown below, nowhere in either figure is an identification for a template indicated.

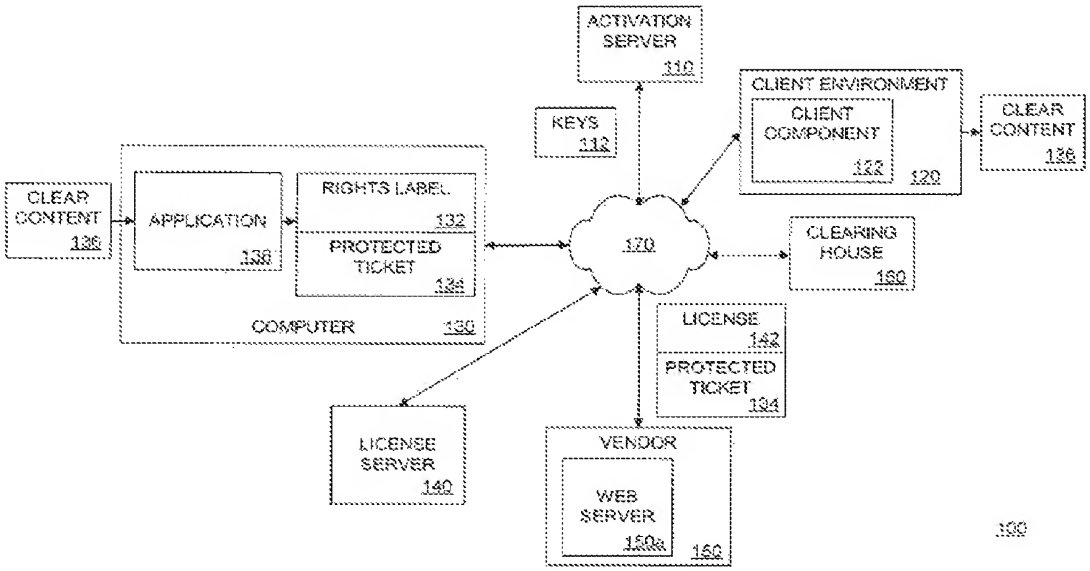

FIG. 1

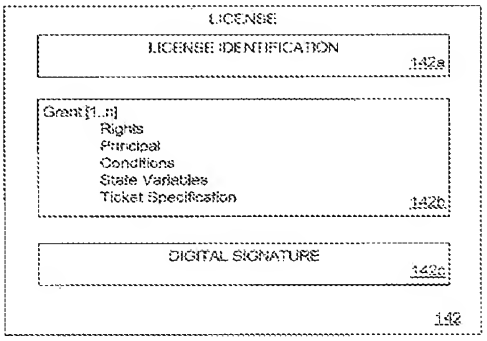

FIG. 3

The accompanying text to Figs. 1 and 3 also fails to disclose generation of an identification for the template. To wit, while Fig. 3 of the Gilliam patent discloses a license identification 142a, this is not the same as the template identification recited in independent claim 1. The accompanying text to Fig. 3 in the Gilliam patent makes this clear stating:

> FIG. 3 illustrates an exemplary license that can be employed in the exemplary systems of FIGS. 1 and 5. In FIG. 3, a rights expression in the form of the license 142, for example, can include a unique license identification (ID) 142a and a grant 142b, for example, including usage rights, a principal, conditions, state variables, and a ticket specification designating an associated item ticket 134. The license 142 also can include a digital signature 142c, including any suitable cryptographic keys, and the like, for unlocking item ticket 134.

See col. 6, lines 47-56 of the Gilliam patent.

Similarly, the accompanying text to Figure 1 in the Gilliam patent describes a digital rights management system and the modules and components that make up the system, but nowhere in the Gilliam patent is there any indication of generation of a template identification as recited by independent claim 1 of the present application. As such, Appellants respectfully submit that the Gilliam patent fails to disclose or suggest generating an identification for said template as recited in claim 1 of the present application.

5. The Gilliam Patent Does Not Disclose or Suggest Transmitting the Identification for the Template to a Device

Independent claim 1 of the present application recites transmitting the identification for the template to a device adapted to situationally determine the variable and enforce the rights expression information based on the variable and the identification for the template. Since the Gilliam patent fails to disclose generating an identification for the template, the Gilliam patent cannot disclose transmitting the generated identification for the template to a device, much less a device adapted to situationally determine the variable and enforce the rights expression information based on the variable and the identification for the template.

The Examiner asserts that the Gilliam patent discloses this limitation and refers to the Abstract and claim 1 of the Gilliam patent to support this assertion. The Abstract of the Gilliam patent discloses:

> A system and method for enforcing rights expressions specifying manners of use of an item, include specifying by a potential recipient of an item a first rights expression indicating a first manner of use of the item proposed by the recipient; specifying by a provider of the item a second rights expression indicating a second manner of use of the item proposed by the provider; determining if there is a correspondence between the first rights expression and the second rights expression; and applying a rule to a determined correspondence between the first rights expression and the second rights expression to determine if the recipient should be granted use of the item.

Likewise, claim 1 of the Gilliam patent recites:

> 1. A method for enforcing rights expressions specifying manners of use of an item, said method comprising:
> specifying by a potential recipient of an item a first rights expression indicating a first manner of use of said item proposed by said recipient;
> specifying by a provider of said item a second rights expression indicating a second manner of use of said item proposed by said provider;
> determining if there is a correspondence between said first fights expression and said second fights expression;
> applying a rule to a determined correspondence between said first rights expression and said second rights expression to determine if said recipient should be granted said first manner of use of said item; and
> granting said first manner of use to said recipient, if said rule determines that said recipient should be granted said first manner of use of said item.

As shown above, nowhere in the cited portions of the Gilliam patent is there any disclosure or suggestion of transmitting the identification for the template to a device adapted to situationally determine the variable and enforce the rights expression information based on the variable and the identification for the template. As evident in the Abstract and in claim 1, the method of enforcing rights expressions of the Gilliam patent focuses on a recipient indicating a manner of use of an item, a provider also indicating a manner of use for the item, and determining if the manners of use correspond. If the manners of use correspond, a rule is applied to determine if the recipient should be granted the manner of use for the item. There is no disclosure or suggestion of transmitting a template identification to a device that is adapted to determine the variable and then enforce the rights expression information based on

the variable and the template identification, and the Examiner provides no further indication of the manner in which the Gilliam patent was interpreted as meeting the claimed limitation.

As such, Appellants respectfully submit that the Gilliam patent fails to disclose or suggest transmitting the identification for the template to a device adapted to situationally determine the variable and enforce the rights expression information based on the variable and the identification for the template as recited in claim 1 of the present application.

6. The Gilliam Patent Does Not Disclose or Suggest the Rights Expression Information Can Be Enforced on a Device Based on the Variable and the Identification for the Template

Independent claim 1 of the present application recites specifying rights expression information whereby rights expression information can be enforced on a device based on the variable and the identification for the template.

As outlined above, the Examiner asserts that the Gilliam patent discloses this limitation and cites the Abstract and claim 1 of the Gilliam patent to support this assertion. The Gilliam patent fails to disclose or suggest rights expression information that can be enforced on a device based on the variable and the identification for the template as recited in claim 1 of the present application. Instead, the Abstract of the Gilliam patent merely describes enforcing rights expressions specifying manners of use of an item. The Gilliam patent discusses managing usage rights based on rules but fails to disclose or suggest that rights expression information is enforced on a device based on the variable and the identification for the template. Similarly, claim 1 of the Gilliam patent merely recites a method for enforcing rights expressions by matching a potential recipient of an item (and their first rights expression) to the provider of the item (and their second rights expression). If the rights expressions match, the manner of use may be granted.

In contrast, in the present application, the profile of the rights expression information identifies subsets of the rights expression language that a particular interpreter supports and interprets by an encoding process that removes one or more values for variable fields from a rights expression (see paragraphs [0041-0046] of the present application). Profiling is employed to allow resource-constrained devices to participate in a rights-interpreted language system. See paragraph [0043] of the present application. The device can interpret the rights expression by looking up a template using the template identifier and use the values for the variable fields to reconstruct the rights expression. In this fashion, the full rights expression does not need to be transmitted to the device. See paragraphs [0044-0046].

The Gilliam patent does not teach or suggest a device enforcing the rights expression information based on the variable and the identification for the template. As indicated above, the Gilliam patent fails to disclose or suggest all the elements recited in amended independent claim 1 of the present application. Appellants respectfully submit that the Gilliam patent fails to anticipate independent claim 1 under 35 U.S.C. § 102(e) and that independent claim 1 is in proper condition for allowance. Appellants respectfully request reconsideration of independent claim 1 and the REVERSAL of the rejection under 35 U.S.C. § 102(e).

7. The Dependent Claims and the Related Claims Are Not Anticipated by the Gilliam Patent

Claims 3 and 4 and claims 8-10 of the present application depend upon independent claim 1 and thereby include all the limitations of claim 1 while reciting additional features of a method of the present invention. Appellants respectfully request REVERSAL of the rejection of claims 3 and 4 and claims 8-10 for similar reasons as outlined above with regard to the rejection of claim 1 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose or suggest all the elements and limitations recited in independent claim 1 of

the present application. Therefore, the applied reference also fails to disclose or suggest all the features and limitations of dependent claims 3 and 4 and claims 8-10 as well. Accordingly, Appellants respectfully submit that claims 3 and 4 and claims 8-10 are allowable at least by virtue of their dependency upon claim 1 as outlined above. Appellants respectfully request reconsideration and REVERSAL of the rejection of claims 3 and 4 and claims 8-10 under 35 U.S.C. § 102.

Claim 5 recites a related method of the present invention similar to amended independent claim 1 of the present application. Claim 1 and claim 5 are related claims that recite methods for determining untransmitted variable values in accordance with the present invention.

Claim 1 recites the case where the untransmitted variable value is determined based on the situation. For example, if the template identification was for a region-locked rights expression, instead of transmitting the template identification along with the region "US" to a device situated in the United States, a sender could just transmit the template identification if he expected the device to automatically fill in the unspecified region variable with the value "US".

Similarly, claim 5 recites the case where the untransmitted variable value is determined by instructions transmitted along with the template identification. For example, if the template identification was for a region-locked rights expression, instead of transmitting the template identification along with the region "US" to a device situated in the United States, a sender could transmit the template identification along with a piece of code such as "mapUnit.GetCountry(gpsUnit.GetLocation())". The device would run that piece of code, which, since the device is in the US, would result in a value of "US" being returned. The device would then use this value for the variable.

As an additional example, claim 5 can also cover a case where a rights expression is for viewing, printing, and extracting of a document. The template used in this case might have three variables for the expiration dates of viewing, printing, and extracting, respectively. However, instead of transmitting all the variable values, perhaps only the expiration date for viewing is transmitted. Additionally, instructions for the other two variables are transmitted, such as "printingExpiration = viewingExpiration – 7 days; extractingExpiration = printingExpiration – 7 days". In this case, everything to reconstruct the rights expression is transmitted and nothing needs to be determined from context.

As outlined above with regard to amended claim 1, however, the Gilliam patent fails to disclose or suggest all the elements and limitations recited in independent claim 1 of the present application. Similarly, the Gilliam patent also fails to disclose all the related elements and limitations of independent claim 5 as well.

Similarly, independent claim 11 recites a system in means-plus-function form that carries out the method recited in independent claim 1. As such, the limitations and features of independent claim 11 are closely related to the steps recited in independent method claim 1. For at least the reasons outlined above with regard to claim 1, Appellants respectfully submit that the Gilliam patent also fails to disclose or suggest all the elements recited by claim 11 of the present invention. Therefore, Appellants respectfully submit that claim 11 is allowable over the cited reference for at least the reasons outlined above with regard to claim 1. Appellants respectfully request that the rejection of claim 11 under 35 U.S.C. § 102 be REVERSED.

Claims 13, 14, and 18-22 of the present application are system claims that depend upon claim 11 and thereby include all the limitations of independent claim 11 while reciting additional features of a system of the present invention. Appellants respectfully request REVERSAL of the rejection of claims 13, 14, and 18-22 for similar reasons as outlined

above with regard to the rejection of claim 11 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose or suggest all the elements and limitations recited in independent claim 11 of the present application. Therefore, the applied reference fails to disclose or suggest all the features and limitations of dependent claims 13, 14, and 18-22, as well. Accordingly, Appellants respectfully submit that claims 13, 14, and 18-22 are allowable at least by virtue of their dependency upon claim 11 as outlined above. Appellants respectfully request reconsideration and REVERSAL of the rejection of claims 13, 14, and 18-22 under 35 U.S.C. § 102.

Claim 15 recites a related system of the present invention similar to the system recited in independent claim 11 of the present application. Claims 11 recites the case where the untransmitted variable value is determined based on the situation, and claim 15 recites the case where the untransmitted variable value is determined by instructions transmitted along with the template identification. Both claims 11 and 15 recite systems for determining untransmitted variable values in accordance with the present invention.

As outlined above with regard to claims 1, 5, and 11, the Gilliam patent fails to disclose or suggest all the elements and limitations recited in independent claims 15, and 11 of the present application. Similarly, the Gilliam patent also fails to disclose or suggest all the related elements and limitations of independent claim 15 as well. Therefore, Appellants respectfully submit that claim 15 is allowable over the cited reference for at least the reasons outlined above with regard to claims 1, 5, and 11. Appellants respectfully request that the rejection of claim 15 under 35 U.S.C. § 102 be REVERSED.

As above, claims 16 and 17 depend upon independent claim 15. These dependent claims thereby include all the limitations of independent claim 15 while reciting additional features of systems of the present invention. Applicants respectfully request REVERSAL of the rejection of claims 16 and 17 for similar reasons as outlined above with regard to the

rejection of claim 15 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose or suggest all the elements and limitations recited in independent claim 15 of the present application. Therefore, the applied reference fails to disclose all the features and limitations of dependent claims 16 and 17 as well. Accordingly, Appellants respectfully submit that claims 16 and 17 are allowable at least by virtue of their dependency upon claim 15 as outlined above. Appellants respectfully request reconsideration and withdrawal of the rejection of claims 16 and 17 under 35 U.S.C. § 102.

Amended independent claim 23 recites a device in means-plus-function form for controlling use of an item in accordance with a rights expression created in accordance with the method recited in independent claim 1. As such, the limitations and features of independent claim 23 are closely related to the steps recited in independent method claim 1 and in system claim 11. As was the case with the method of claim 1 and system claim 11 Appellants respectfully submit that the Gilliam patent fails to disclose all the elements recited by claim 23 of the present invention. Therefore, Appellants respectfully submit that claim 23 is allowable over the cited reference for at least the reasons outlined above with regard to claims 1 and 11. Appellants respectfully request that the rejection of claim 23 under 35 U.S.C. § 102 be REVERSED.

Likewise, claims 25, 26, and 30-33 of the present application depend upon claim 23 and thereby include all the limitations of independent claim 23 while reciting additional features of a device of the present invention. Appellants respectfully request REVERSAL of the rejection of claims 25, 26, and 30-33 for similar reasons as outlined above with regard to the rejection of claim 23 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose or suggest all the elements and limitations recited in independent claim 23 of the present application. Therefore, the applied reference fails to disclose all the features and limitations of dependent claims 25, 26, and 30-33 as well. Accordingly, Appellants

respectfully submit that claims 25, 26, and 30-33 are allowable at least by virtue of their dependency upon claim 23 as outlined above. Appellants respectfully request reconsideration and REVERSAL of the rejection of claims 25, 26, and 30-33 under 35 U.S.C. § 102.

Claim 27 recites a related device of the present invention similar to the device recited in independent claim 23 of the present application. Claim 23 recites the case where the untransmitted variable value is determined based on the situation, and claim 27 recites the case where the untransmitted variable value is determined by instructions transmitted along with the template identification. Both claims 23 and 27 recite systems for determining untransmitted variable values in accordance with the present invention.

As outlined above with regard to amended claims 1, 5, 11, 15, and 23, however, the Gilliam patent fails to disclose or suggest all the elements and limitations recited in these independent claims of the present application. Similarly, the Gilliam patent also fails to disclose or suggest all the related elements and limitations of independent claim 27 as well. Appellants respectfully submit that claim 27 is allowable over the cited reference for at least the reasons outlined above with regard to claims 1, 5, 11, 15, and 23. Appellants respectfully request that the rejection of claim 27 under 35 U.S.C. § 102 be withdrawn.

As above, claims 28 and 29 depend upon independent claim 27. These dependent claims thereby include all the limitations of independent claim 27 while reciting additional features of devices of the present invention. Appellants respectfully request REVERSAL of the rejection of claims 28 and 29 for similar reasons as outlined above with regard to the rejection of claim 27 under 35 U.S.C. § 102. As discussed above, the cited reference fails to disclose or suggest all the elements and limitations recited in independent claim 27 of the present application. Therefore, the applied reference fails to disclose all the features and limitations of dependent claims 28 and 29 as well. Accordingly, Appellants respectfully submit that dependent claims 28 and 29 are allowable at least by virtue of their dependency

upon claim 27 as outlined above. Appellants respectfully request reconsideration and REVERSAL of the rejection of claims 28 and 29 under 35 U.S.C. § 102.

B. **Claims Recited Using "Means For" Language**

In paragraph 8 of the March 21, 2008, non-final Office Action, and in paragraph 7 of the October 17, 2008, Final Office Action, the Examiner took the position that "the 'means for' phrase(s) [in claim 11 and claims 13-33] do not invoke 35 U.S.C. 112, 6th paragraph [sic]." The Examiner required "Applicant(s) to either amend the claim(s) to remove all instances of 'means for' from the claims(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked." This position is contrary to settled case law.

The Court of Appeals for the Federal Circuit held that a means or step-plus function limitation should be interpreted by the U.S. Patent and Trademark Office with regard to the structure, material, or acts disclosed in the specification and equivalents that correspond to such language. *See In re Donaldson,* 16 F.3d 1189, 1193 (Fed. Cir. 1994).

A claim limitation will invoke 35 U.S.C. §112, sixth paragraph, if it meets the following 3-prong analysis, namely (a) the claim limitations must use the phrase "means for" or "step for;" (b) the "means for" or "step for" must be modified by functional language; and (c) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function. See MPEP 2181; s*ee also In re Donaldson,* 16 F.3d 1189, 1193 (Fed. Cir. 1994); *see also Watts v. XL Systems, Inc.*, 232 F.3d 877, 881 (Fed. Cir. 2000); *see also York Prod., Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574 (Fed. Cir. 1996).

A claim element not using "means for" or "step for" will not be considered to invoke 35 U.S.C. §112, sixth paragraph. The term "means" gives rise to a presumption that the inventor used the term advisedly to involve the statutory mandates for means-plus-function

clauses. *See York Prod., Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574 (Fed. Cir. 1996); *see also Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1583 (Fed. Cir. 1996) ("detent mechanism" defined in functional terms was not intended to invoke 35 U.S.C. § 112, sixth paragraph").

In response to the non-final Office Action, Appellants filed an Amendment on June 13, 2008 and requested additional explanation from the Examiner. Specifically, Appellants requested an additional explanation as to why the Examiner believed that the subject claims do not invoke 35 U.S.C. §112, sixth paragraph. While the Examiner's assertion and requirement was repeated verbatim in the Final Office Action mailed October 17, 2008, Appellants received no additional explanation. As such, Appellants respectfully request that the Board construe the claims in accordance with Federal Circuit precedent and the plain meaning of the statute.

VIII. CONCLUSION

For all of the reasons discussed above, Appellants respectfully submit that all pending claims 1, 3-11, 13-23, and 25-33 are patentable under 35 U.S.C. § 102. Accordingly, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1, 3-20, 22-37, and 39-54.

Respectfully submitted,

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IX. CLAIMS APPENDIX

1. (Previously Presented) A method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression, said method comprising:

specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable;

generating a template of said rights expression information, including removing said value for said variable from said element;

generating an identification for said template; and

transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template,

whereby said rights expression information can be enforced on a device based on said variable and said identification for said template.

2. (Canceled)

3. (Previously Presented) The method of claim 1, wherein said transmitting step comprises:

transmitting one or more variables associated with said identification for said template in a predetermined order and situationally determining untransmitted variables.

4. (Previously Presented) The method of claim 1, wherein said transmitting step comprises:

transmitting one or more variables associated with said identification for said template in a non-predetermined order and situationally determining untransmitted variables.

5. (Previously Presented) A method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression, said method comprising:

specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable;

generating a template of said rights expression information, including removing said value for said variable from said element;

generating an identification for said template;

transmitting said identification for said template along with machine-interpretable reconstruction instructions to a device, wherein said device is adapted to follow said machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template;

whereby said rights expression information can be enforced on a device based on said variable and said identification for said template.

6. (Previously Presented) The method of claim 5, wherein said transmitting step comprises:

transmitting one or more variables associated with said identification for said template in a predetermined order and determining untransmitted variables according to said machine-interpretable reconstruction instructions.

7. (Previously Presented) The method of claim 5, wherein said transmitting step comprises:

transmitting one or more variables associated with said identification for said template in a non-predetermined order and determining the untransmitted variables according to said machine-interpretable reconstruction instructions.

8. (Previously Presented) The method of claim 1, further comprising:

transmitting said identification for said template to a device adapted to follow machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template.

9. (Previously Presented) The method of claim 8, wherein said transmitting step comprises:

transmitting one or more variables associated with said identification for said template in a predetermined order, determining the machine-interpretable reconstruction instructions associated with said template, and determining untransmitted variables according to said machine-interpretable reconstruction instructions.

10. (Previously Presented) The method of claim 8, wherein said transmitting step comprises:

transmitting one or more variables associated with said identification for said template in a non-predetermined order, determining the machine-interpretable reconstruction instructions associated with said template, and determining the untransmitted variables according to said machine-interpretable reconstruction instructions.

11. (Previously Presented) A system for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression, said system comprising:

means for specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable;

means for generating a template of said rights expression information, including removing said value for said variable from said element;

means for generating an identification for said template; and

means for transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template,

whereby said rights expression information can be enforced on a device based on said variable and said identification for said template.

12. (Canceled)

13. (Previously Presented) The system of claim 11, wherein said transmitting means comprises:

means for transmitting one or more variables associated with said identification for said template in a predetermined order and situationally determining untransmitted variables.

14. (Previously Presented) The system of claim 11, wherein said transmitting means comprises:

means for transmitting one or more variables associated with said identification for said template in a non-predetermined order and situationally determining the untransmitted variables.

15. (Previously Presented) A system for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression, said system comprising:

means for specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable;

means for generating a template of said rights expression information, including removing said value for said variable from said element; ~~and~~

means for generating an identification for said template; and

means for transmitting said identification for said template along with machine-interpretable reconstruction instructions to a device, wherein said device is adapted to follow said machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template.

whereby said rights expression information can be enforced on a device based on said variable and said identification for said template.

16. (Previously Presented) The system of claim 15, wherein said transmitting means comprises:

means for transmitting one or more variables associated with said identification for said template in a predetermined order and determining untransmitted variables according to said machine-interpretable reconstruction instructions.

17. (Previously Presented) The system of claim 15, wherein said transmitting means comprises:

means for transmitting one or more variables associated with said identification for said template in a non-predetermined order and determining the untransmitted variables according to said machine-interpretable reconstruction instructions.

18. (Previously Presented) The system of claim 11, further comprising:

means for transmitting said identification for said template to a device, wherein said device is adapted to follow machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template.

19. (Previously Presented) The system of claim 18, wherein said transmitting means comprises:

means for transmitting one or more variables associated with said identification for said template in a predetermined order, determining the machine-interpretable reconstruction

instructions associated with said template, and determining untransmitted variables according to said machine-interpretable reconstruction instructions.

20. (Previously Presented) The system of claim 18, wherein said transmitting means comprises:

means for transmitting one or more variables associated with said identification for said template in a non-predetermined order, determining the machine-interpretable reconstruction instructions associated with said template, and determining the untransmitted variables according to said machine-interpretable reconstruction instructions.

21. (Previously Presented) The system of claim 11, wherein said means for specifying, said means for generating said template and said means for generating said identification comprise devices of a computer system.

22. (Previously Presented) The system of claim 11, wherein said means for specifying, said means for generating said template and said means for generating said identification comprise computer readable instructions recorded on a computer readable medium.

23. (Previously Presented) A device for controlling use of an item in accordance with a rights expression for use in system for creating the rights expression for association with the item, said device comprising:

means for receiving an identification for a template of rights expression information and a variable from said rights expression information, said rights expression information indicating a manner of use of an item and including at least one element having said variable

and a corresponding value for said variable, said template of said rights expression information, including said value for said variable removed from said element; and

means for situationally determining said variable and enforcing said rights expression information based on said variable and said identification for said template.

24. (Canceled)

25. (Previously Presented) The device of claim 23, wherein said rights expression information includes one or more variables associated with said identification for said template received in a predetermined order and the device further includes means for situationally determining untransmitted variables.

26. (Previously Presented) The device of claim 23, wherein said rights expression information includes one or more variables associated with said identification for said template received in a non-predetermined order and the device further includes means for situationally determining the untransmitted variables.

27. (Previously Presented) A device for controlling use of an item in accordance with a rights expression for use in system for creating the rights expression for association with the item, said device comprising:

means for receiving an identification for a template of rights expression information and a variable from said rights expression information, said rights expression information indicating a manner of use of an item and including at least one element having said variable and a corresponding value for said variable, said template of said rights expression information, including said value for said variable removed from said element;

means for situationally determining said variable and enforcing said rights expression information based on said variable and said identification for said template.

means for receiving said identification for said template along with machine-interpretable reconstruction instructions; and

means for following said machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template.

28. (Previously Presented) The device of claim 27, wherein said rights expression information includes one or more variables associated with said identification for said template received in a predetermined order and the device further includes means for determining untransmitted variables according to said machine-interpretable reconstruction instructions.

29. (Previously Presented) The device of claim 27, wherein said rights expression information includes one or more variables associated with said identification for said template received in a non-predetermined order and the device further includes means for determining the untransmitted variables according to said machine-interpretable reconstruction instructions.

30. (Previously Presented) The device of claim 23, further comprising:

means for receiving said identification for said template; and

means for following machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template.

31. (Previously Presented) The device of claim 30, wherein said rights expression information includes one or more variables associated with said identification for said template received in a predetermined order and the device further includes means for determining the machine-interpretable reconstruction instructions associated with said template, and means for determining untransmitted variables according to said machine-interpretable reconstruction instructions.

32. (Previously Presented) The device of claim 30, wherein said rights expression information includes one or more variables associated with said identification for said template received in a non-predetermined order and the device further includes means for determining the machine-interpretable reconstruction instructions associated with said template, and means for determining the untransmitted variables according to said machine-interpretable reconstruction instructions.

33. (Original) The device of claim 23, wherein said means for receiving and said means for enforcing comprise computer readable instructions recorded on a computer readable medium.

X. EVIDENCE APPENDIX

There is no additional evidence related to this Appeal.

XI. RELATED PROCEEDINGS APPENDIX

There are no related proceedings to this Appeal.